



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,151	12/27/2001	Lorenzo Mendizabal	Hartford-9	1595

45722 7590 08/14/2006

PLEVY & HOWARD, P.C.  
P.O. BOX 226  
FORT WASHINGTON, PA 19034

EXAMINER
----------

LANEAU, RONALD

ART UNIT	PAPER NUMBER
----------	--------------

3627

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/034,151	<b>Applicant(s)</b> MENDIZABAL ET AL.	
	<b>Examiner</b> Ronald Laneau	<b>Art Unit</b> 3627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3627

1. In view of the Appeal Brief filed on 5/19/06, PROSECUTION IS HEREBY REOPENED. A new ground of rejection sets forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

  
Alexander Kalinowski

***Status of Claims***

2. Claims 2-13 and 15-21 are cancelled and claims 1 and 14 are now pending.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodwin et al (US 2003/0220867 A1) in view of McAfee et al (US 6,718,312 B1).

As per claims 1, 6-9, 12-14 and 17-21, Goodwin discloses a computer method of auctioning at least one claim or asset in bankruptcy over a communication network, said method comprising the steps of: identifying potential buyers for said at least one claim or asset using at least one of a plurality of factors, the factors comprising previous purchasing behavior, industry links, and market research (page 7, [0101]); notifying selected ones of the potential buyers of the availability of said at least one claim or asset (page 10, box [0118]); registering ones of said buyers who have expressed an interest in bidding on said at least one claim or asset (page 11, box [0131]); obtaining bids from said registered buyers over the network (page 1, boxes [0003], [0004]); and accepting a highest one of said bids if said highest one of said bids satisfies a predetermined criteria and notifying said registered buyer from which said highest one of said bids was obtained of the acceptance thereof; or rejecting said bids if said bids do not satisfy said predetermined criteria (page 9, box [0110]). Goodwin does not explicitly disclose determining a

Art Unit: 3627

market value but McAfee discloses determining a market value of said at least one claim or asset using historical data of same or similar claims or assets; dynamically adjusting said market value based on known factors (col. 5, lines 19-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the fair market value as taught by McAfee into the system of Goodwin because it would provide sophisticated, underlying analytical valuation system that can generate the consistent, dependable values needed for reliable financial markets.

As per claims 3-5, 10 and 11, Goodwin discloses a method wherein the step of determining a market value comprises: accessing historical data of sales of claims or assets previously recorded (page 5, box [0083]); determining an asset unit value based on said historical data; and formulating said market value based on said asset unit value and number of assets available (page 4, [0107]). Neither Goodwin nor McAfee discloses an asset unit value that is determined as a weighted average and wherein said weights are determined in accordance with factors selected from the group comprising: number of assets, duration of sale, or date of sale but it is rather quite obvious that that Goodwin's system is capable of determining the asset value base on factors such as number of assets, duration of sale, or date of sale as claimed.

As per claims 15-16, Goodwin discloses a system comprising at least one input/output device interposed between said communication network and said processor to provide information items from said network to said processor and from processor to said network (see fig. 1), a system that comprises an Internet (see abstract).

***Response to Arguments***

5. Applicant's arguments filed on 5/19/06 have been fully considered but they are not persuasive.

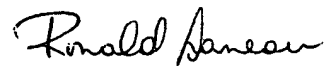
Applicant argues that Goodwin does not disclose, teach or suggest "identifying potential buyers for said at least one claim or asset using at least one of a plurality of factors, the factors comprising previous purchasing behavior, industry links, and market research." In response to Applicant's arguments, a potential buyer can be identified through the use of cookies in the Internet environment. One would be able to see the items of interests of a user navigating the Internet and identify which item such user has a particular interest on and notify said user if the item is up for auction so that said user can entertain the idea of bidding on such item. Claims 1 and 3-21 remain rejected.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571) 272-6784. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ronald Laneau  
Primary Examiner  
Art Unit 3627

8/4/06

rl